

***United States Court of Appeals
for the Second Circuit***



**APPELLANT'S
BRIEF**

74C-1734

UNITED STATES COURT OF APPEALS

FOR THE SECOND CIRCUIT

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LANCASTER COLONY CORPORATION,

Plaintiff-Appellee,

v.

ALDON ACCESSORIES, LTD. and
ROYAL LONDON, LTD.

Defendants-Appellants.
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Docket No.: 74C 1734



APPELLANTS' BRIEF ON APPEAL

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APPELLANTS' BRIEF ON APPEAL

Statement of the Case

The action was brought by the appellee for alleged infringement of Design Patent No. 217,942 relating to an ashtray.

In June, 1973 the appellee filed a Motion for Summary Judgment that the patent in suit was valid and infringed by appellants. Appellants opposed this Motion. During oral argument in late June, the Court below requested that the appellants make a cross Motion for Summary Judgment so that it might dispose of the case and appellants complied. In March, 1974 the Court below granted the appellee's Motion holding the design patent valid and infringed and denied the appellants' Motion.

The sole question presented on this appeal is whether Design Patent No. 217,942 is valid over the prior art relied upon by the appellants in opposing the appellee's Motion below and which was not cited by the Patent Office.

The Patent in Suit is Invalid

The patent in suit is invalid because the differences between the patented subject matter and the prior art are such that the subject matter is completely obvious to any person having ordinary skill in the pertinent art.

The applicable patent statute is as follows:

"A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made." (Title 35 U.S.C. §103)

The standards to be used in applying §103 to design patents were set forth by this Court in 1971 in the case of G.B. Lewis Company v. Gould Products, Inc., 436 F2d 1176. The Court stated (at 1178):

"In Graham v. John Deere Co., 338 U.S. 1, 17, 86 S.Ct. 684, 693, 15 L.Ed.2d 545 (1966), the Supreme Court stated that this provision [§103], added in 1952, 66 Stat. 798, 'was intended merely as a codification of judicial precedents embracing the Hotchkiss condition, with congressional directions that inquiries into the obviousness of the subject matter sought to be patented are a prerequisite to patentability'.

The determination required by Hotchkiss [Hotchkiss v. Greenwood, 52 U.S. (11 How) 248, 266, 13 L.Ed. 683 (1851).]; elusive in any case, is particularly so with respect to a design patent. We have frequently indicated that the requirement of invention is not met by a design which is merely 'new and pleasing enough to catch the trade'; rather we have insisted that the design reflect 'some exceptional talent, beyond the skill of the ordinary designer,' Neufeld-Furst & Co. v. Jay-Day Frocks, Inc., 112 F.2d 715, 716 (2 Cir. 1930). We have noted that in view of this '[t]o obtain a valid design patent is exceedingly difficult.' Chas. D. Briddell, Inc., v. Alglobe Trading Corp., 194 F.2d 416, 419 (2 Cir. 1952)."

The Court then went on to compare the patented design with the prior art and concluded that the design would have been obvious to one of ordinary skill in the art, and that the patent was invalid.

The design patent in suit relates to an ashtray which, viewed from above, is in the form of a trapezoid. It includes the normally required ash receiving trough at one end thereof and the normally required cigar receiving channel extending from the trough to the opposite end of the ashtray.¹

The patent in suit is invalid as the design is completely present in the prior art not considered by the patent office. The basic design features of the patent in suit are shown in their entirety in the Russell patent No. 371,901 except for the

¹ The patent in suit and copies of the prior art were attached as Exhibits to Appellants' Motion for Summary Judgment and are in the Appendix. As this is a design patent matter, for convenience, copies of the drawings of each of the cited patents are also attached to this Brief.

trapezoidal shape and this shape was and is an old and common ashtray configuration as shown by the patents referred to by the Appellant. In fact, the District Court agreed with this conclusion in the instant case and found that "most" of the elements of appellee's design are in the prior art, stating:²

"The Court has carefully studied the prior art submitted by defendants, has compared it with plaintiff's design and finds itself in agreement with defendants' contention that most of the basic elements of plaintiff's design --viz., the trapezoidal shape of the ashtray; a large trapezoidal trough for ashes; and a groove for resting a cigar running the length of the ashtray-- appear in the cited prior art.

These elements are clearly shown in the prior art in patents which were not cited by the Examiner in the Patent Office during the prosecution of the application.

The Court below acknowledged this fact as follows:³

"Although plaintiff claims that since at least one of the prior art references was before the Patent Examiner, the presumption of validity is reinforced - see, e.g. Stevens v. Carl Schmidt, Inc., 73 F.2d 54 (2d Cir.1934), cert. denied, 294 U.S.721 (1934)-- it is well settled that where the Patent Office did not consider pertinent prior art, the presumption is weakened. See e.g., Reeves Bros. Inc., v. U.S. Laminating Corp., 417 F.2d 869 (2d Cir. 1969). An examination of the prior art cited by defendant reveals that at least two of them (Russell No. 371,901 and Segal No. 2,335,973) are clearly pertinent."

Thus, there is virtually no presumption of validity.

²Memorandum Decision p.3

³Memorandum Decision pp.2,3

The Prior Art Clearly Shows Each and Every
Element of the Design of the Patent in Suit

The prior art patents all relate to ashtrays. The Russell patent No. 371,901 is, in and of itself, a clear anticipation of the design of the patent in suit. The Russell patent shows an ashtray with a trough at one end thereof with one side of the trough adjacent to one of the parallel sides of the ashtray and extending to the opposite parallel side. There is a channel extending from the trough to the end of the ashtray opposite the trough. In fact, the striking resemblance between the Russell patent and the patent in suit is clearly shown by a comparison of the lengthwise cross-section of the Russell patent ashtray (Fig.2) and the lengthwise cross-section of the ashtray in the patent in suit (Fig.3). The ashtrays of the Russell patent and the patent in suit are virtually identical throughout any cross-section.

The patent in suit, being a design patent, does not have letters or figures indicating various elements such as those shown in the Russell patent but a comparison will show that the trough shown in Russell (S) is like the trough in the patent in suit (Fig.3). In both, as well as in Segal and Stock, the trough itself

when viewed from above, conforms to the shape and outline of the outer wall. In the Russell patent, the groove G constitutes a channel running from the trough S to the end of the ashtray as does the groove or channel shown in all views of the patent in suit. The sole differences between the Russell ashtray and that of the patent in suit is that the Russell ashtray is rectangular and the patent in suit is somewhat trapezoidal in shape, when viewed from above. This mere change of shape cannot arise to the dignity of invention.

That there is no invention is made even more apparent by other prior art patents which show that a trapezoidal shape was an old and conventional design for ashtrays. The Segal patent, No. 2,335,973, shows a trapezoidal shaped ashtray. The Stock patent, No. 2,641,264 shows a trapezoidal shaped ashtray and also, the Chambers patent, Des. 145,562, shows a trapezoidal shaped ashtray. Thus to minutely modify the Russell ashtray to make it trapezoidal in shape is no invention.

The Segal patent also, by itself, substantially discloses the design of the ashtray of the patent in suit except for the relative size of the trough and the channel and the fact that there is a slope in the height of the ashtray (see Figs. 2,7,8 and 12 of the Segal patent). It is interesting to note that the height of the appellants' ashtray also slopes.

The Russell patent, the Segal patent and the Stock patent were not cited by the Patent Office. The appellee did not call the attention of the Patent Office to these patents although they were and always have been available prior to and during the prosecution of appellee's application issuing into the patent in suit.

The Court below, while mentioning the above-noted patents other than Russell, obviously did not fully consider their disclosure. The chart relied on by the District Court⁴ was an attempt to distinguish the ashtray of the patent in suit only from that shown in the Russell patent. The differences relate to minutiae and size differences which obviously have no bearing on the design itself. In fact, generally patent drawings are not made to scale.

The District Court erred in many instances. For example, the Court in the chart referred to the fact that the ashtray of the Russell patent is rectangular whereas the ashtray of the patent in suit is trapezoidal but thereafter ignored the fact that so many other items of the prior art showed this trapezoidal shape. The minute differences and the dimensional differences which assume that the patents were drawn to scale as shown in the chart are no

⁴.Memorandum Decision p.6.

more than those which could have been made by anyone with ordinary skill in the art with knowledge of the prior art. The patentee is, of course, charged with that knowledge. Thus, even if such minor differences were not found in the prior art, the patent would be invalid. The Court below further erred in elevating structural differences inherent in a trapezoidal shape and in the use of conventional practices such as rounding sharp edges and the like to the dignity of invention and ignoring the fact that these elements are clearly shown in the prior art for incorporation perforce in any desired assemblage.

In fact, the very minute differences between the ashtray of the Russell patent and that of the patent in suit upon which the Court below dwelled in order to find validity are found in the prior art as follows: The sloping of the walls of the trough is clearly shown in the Segal patent (Fig.2) and the Stock patent (Fig.8). The semi-circular groove is shown in the Segal patent (Fig.4) and the Stock patent (Fig.6). The chamfering of edges is a conventional expedient for eliminating right angles and sharp edges. It has been done since time immemorial in the glass and plastic industries. Such chamfering is, in any event, shown in the Segal patent (Figs. 3 and 12) and in the Chambers patent (Fig.2). The opinion of the Court below appears to reflect the fact that the Court did not at all consider that these minute differences, upon which it based its finding of validity over the Russell patent, were completely disclosed in the other patents of the prior art.

The patent design falls far short of reflecting some exceptional talent beyond the skill of the ordinary designer. See G.B. Lewis Company v. Gould Products, Inc. (supra).

The Law Supports the Conclusion that the
Patent In Suit is Invalid

The law in the Court is as set forth in G.B. Lewis Company v. Gould Products, Inc., (supra) wherein the Court said (p.1178):

"We have frequently indicated that the requirement of invention is not met by a design which is merely 'new and pleasing enough to catch the trade'; rather we have insisted that the design reflect 'some exceptional talent beyond the skill of the ordinary designer,'"

See also Neufeld-Furst & Co. v. Jay-Day Frocks, Inc., 112 F.2d 715, 716 45 USPQ 632 (2d Cir.1940).

In Blisscraft of Hollywood v. United Plastics Co., 294 F.2d 694, 131 USPQ 55, 57, 58 (2d Cir.1961) the Court said (p.696):

"Reference to the prior art discloses that plaintiff's pitcher is a combination of features of containers which were well known before plaintiff's production was begun. Of course, the mere fact that a person has utilized in combination a number of elements which severally were well known, will not defeat the patentability of the combination...But the utilization of old elements in combination must represent an exercise of creative talent beyond that of the ordinary designer chargeable with knowledge of the prior art...What plaintiff did amounted to nothing more than an outstanding regrouping of old elements which demonstrated no originality born of inventive faculty. This is not enough."

There certainly is no more than a mere grouping of old elements in the patent in suit. In fact, the ashtray of the Russell patent merely made trapezoidal like the ashtray in the Segal and Stock patents, is the ashtray of the patent in suit.

See Hygienic Specialties Co. v.H.G. Salzman, Inc. et al.,
302,F.2d 614, 133 USPQ 96 (2d Cir.1962). In this latter case,
the Court held that (P.617):

"The degree of difference required to establish novelty is manifested when the average observer takes the new design for a different, and not a modified already existing design."

In the instant case there is a situation where appellee has utilized only and entirely the expired prior art.

While appellee did not mark its ashtray or the containers therefor with any patent notice whatsoever and the appellant did not know of any such claim of right when it first purchased its ashtray from a supplier for resale, appellee has claimed some commercial success. In this connection a pertinent case is Payne Metal Enterprises, Limited et al., v. McPhee, et al., 382 F.2d 541, 155 USPQ 123 (9th Cir.1967), and particularly the portions under headnotes 7 and 8, where the Court found that while indeed commercial success might show newness in a design, this fact certainly gave no indication that the design was

non-obvious. In this record the same Court adhered to its earlier decision in Brunswick Corporation v. Columbia Industries, Inc. 362 F.2d 172, 175, 150 USPQ 83, 86, 9th Cir., which held that (p.175):

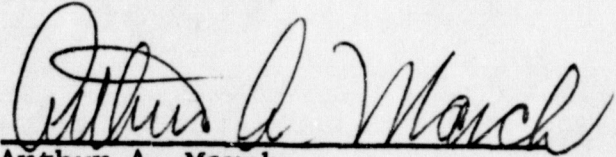
"The law appears to be clear that such factors cannot make patentable a patent which is invalid for lack of invention."

In W.A. Baum Co. Inc., v. Propper Mfg. Co., 343 F.Supp.1016 174 USPQ 22 (D.C. EDNY 1972) it is worth noting how strongly the Court, speaking through Judge Bruchhausen, relies upon the doctrine of Graham v. Deere Company, 383 U.S. 17, 148 USPQ 466 and pointed out that commercial success cannot establish patentability when the evidence of obviousness is strong, citing Continental Can Co., v. Old Dominion Box Co., 393 F.2d, 321, 326, 157 USPQ 353, 356, 2d Cir. 1968. Also, it is to be noted that again the Lewis v. Gould case, supra, is relied upon, and the Court quotes from the holding in Hygienic Specialties (supra) and relied very strongly on this case.

Conclusion

The patent in suit is invalid since the features of the patent are fully disclosed in the prior art and whatever differences exist

are such that the subject matter is completely obvious to any person having ordinary skill in the pertinent art. It is submitted that the decision of the District Court should be reversed and Des. Patent No. 217,942 be declared invalid.

A handwritten signature in cursive script, reading "Arthur A. March". The signature is written in dark ink and is positioned above the printed name and address.

Arthur A. March
60 East 42nd Street
New York, New York 10017
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Service is acknowledged of a copy of the accompanying
Brief, Appendix and Exhibits this 8th day of August, 1974.

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United States Patent Office

Des. 217,942
Patented June 30, 1970

217,942

ASHTRAY

Nicholas P. Angelakos, Brooklyn, N.Y., assignor to
Lancaster Colony Corporation, a corporation of
Delaware

Filed Aug. 8, 1969, Ser. No. 18,600

Term of patent 14 years

Int. Cl. D27-03

U.S. Cl. D85-2

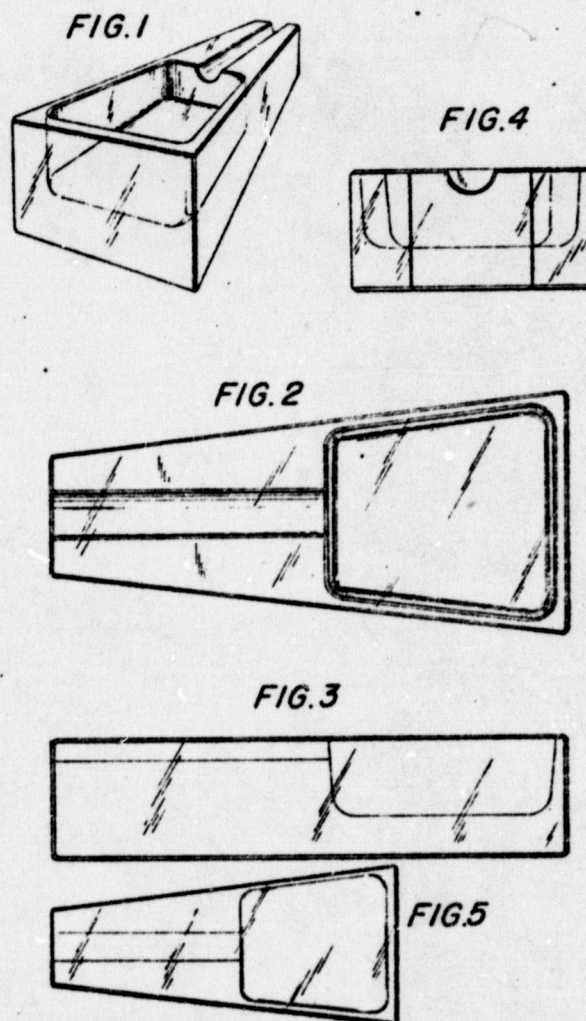


FIG. 1 is a perspective view of an ashtray showing my
new design;
FIG. 2 is a top view;
FIG. 3 is a side view;
FIG. 4 is a rear view; and
FIG. 5 is a bottom on a reduced scale.
I claim:
The ornamental design for an ashtray, substantially
as shown.

References Cited

UNITED STATES PATENTS

D. 145,562	9/1946	Chambers	D85-8	✓
D. 172,873	8/1954	Gayle et al.	D85-2	✓
D. 199,716	12/1964	Gluck	D85-2	✓

OTHER REFERENCES

National Jeweler, March 1931, p. 69, Art Metal Works
ashtray.

Office Appliances, June 1958, p. 38, item 1, ashtray. ✓

ROBERT C. SPANGLER, Primary Examiner

131-241

(No Model.)

J. L. RUSSELL.

COMBINED PAPER WEIGHT AND CIGAR AND ASH HOLDER.

No. 371,901.

Patented Oct. 18, 1887.

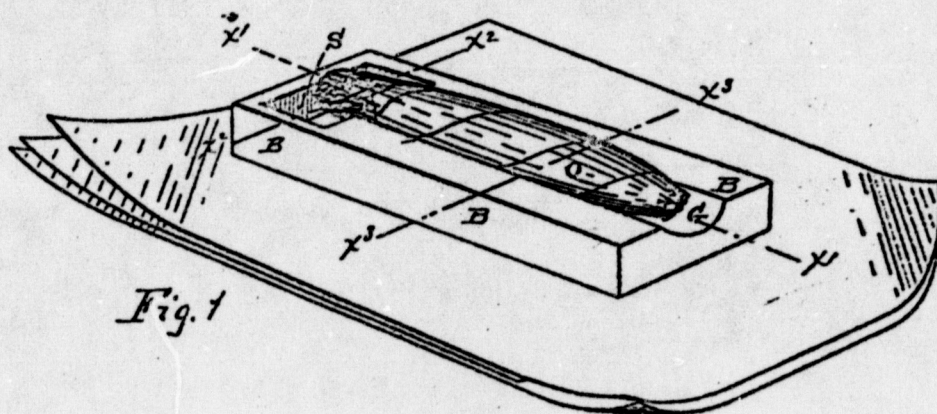


Fig. 1

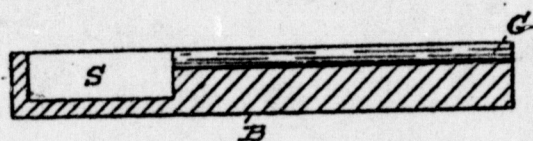


Fig. 2

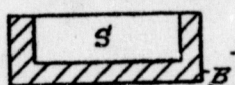


Fig. 3



Fig. 4

WITNESSES

Geo. A. Garby.

Charles S. Brimhall

INVENTOR

John L. Russell

by W. E. Hagan, atty

Dec. 7, 1943.

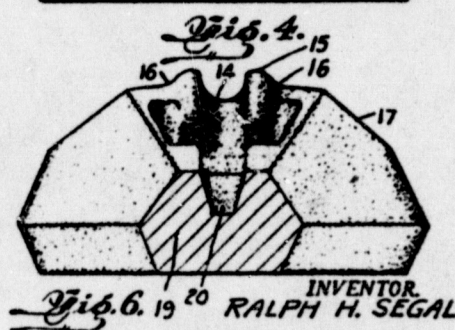
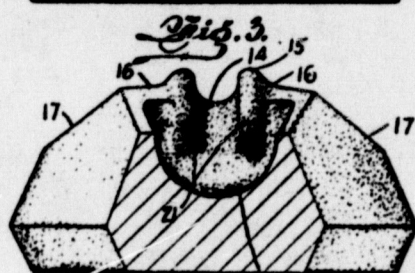
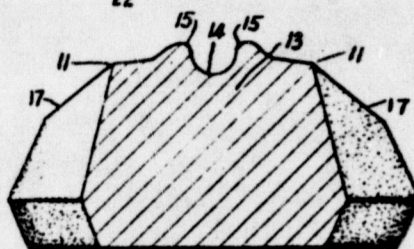
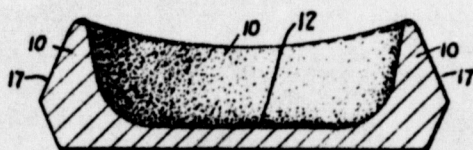
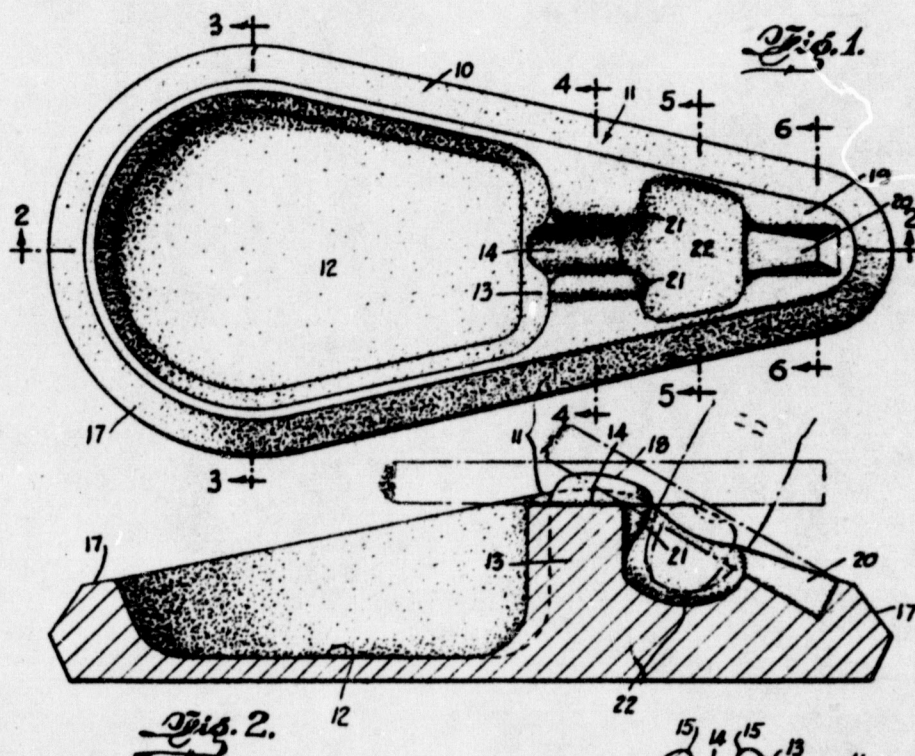
R. H. SEGAL

2,335,973

ASH TRAY

Filed July 10, 1943

3 Sheets-Sheet 1

INVENTOR
RALPH H. SEGALBY
Grey Truman
ATTORNEY.

Dec. 7, 1943.

R. H. SEGAL

2,335,973

ASH TRAY

Filed July 10, 1943

3 Sheets-Sheet 2

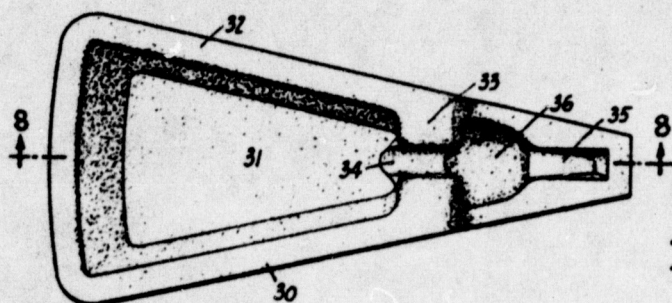


Fig. 7.

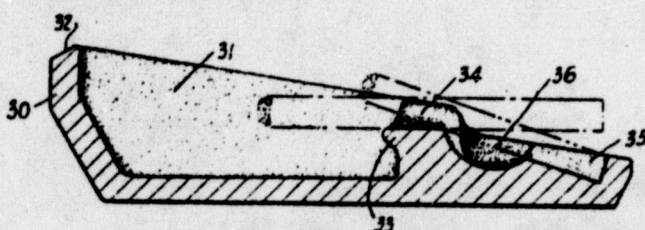


Fig. 8.

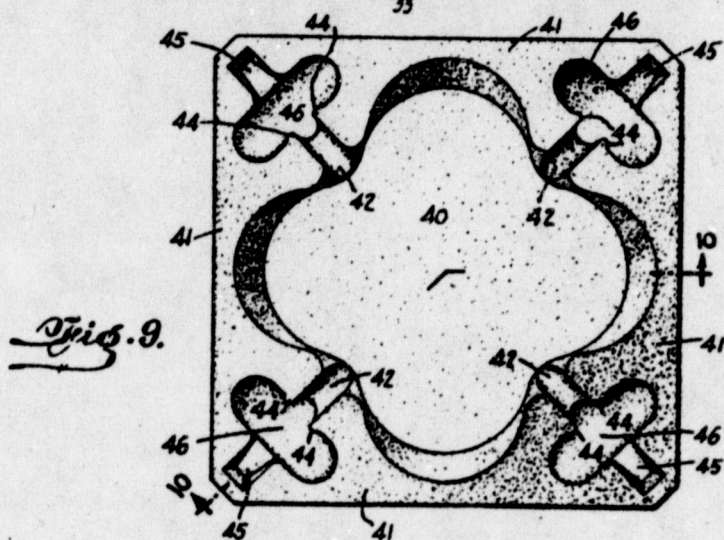


Fig. 9.

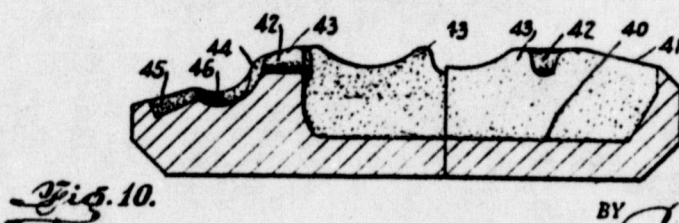


Fig. 10.

INVENTOR.
RALPH H. SEGAL.

BY

Gregg Truman
ATTORNEY.

Dec. 7, 1943.

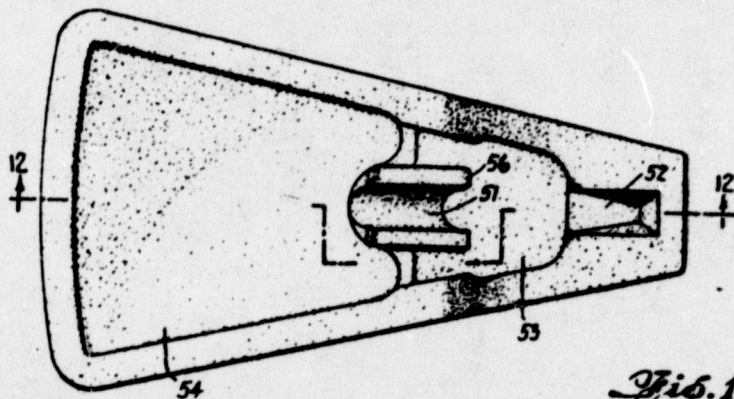
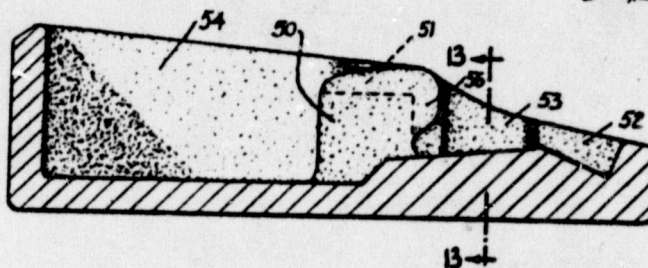
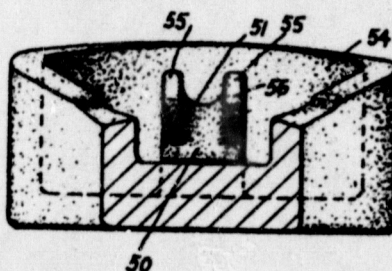
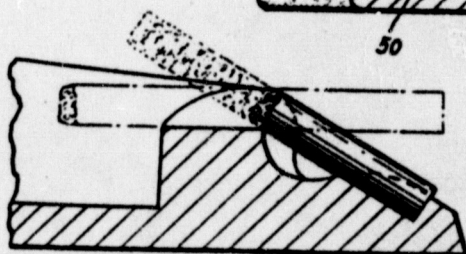
R. H. SEGAL

2,335,973

ASH TRAY

Filed July 10, 1943

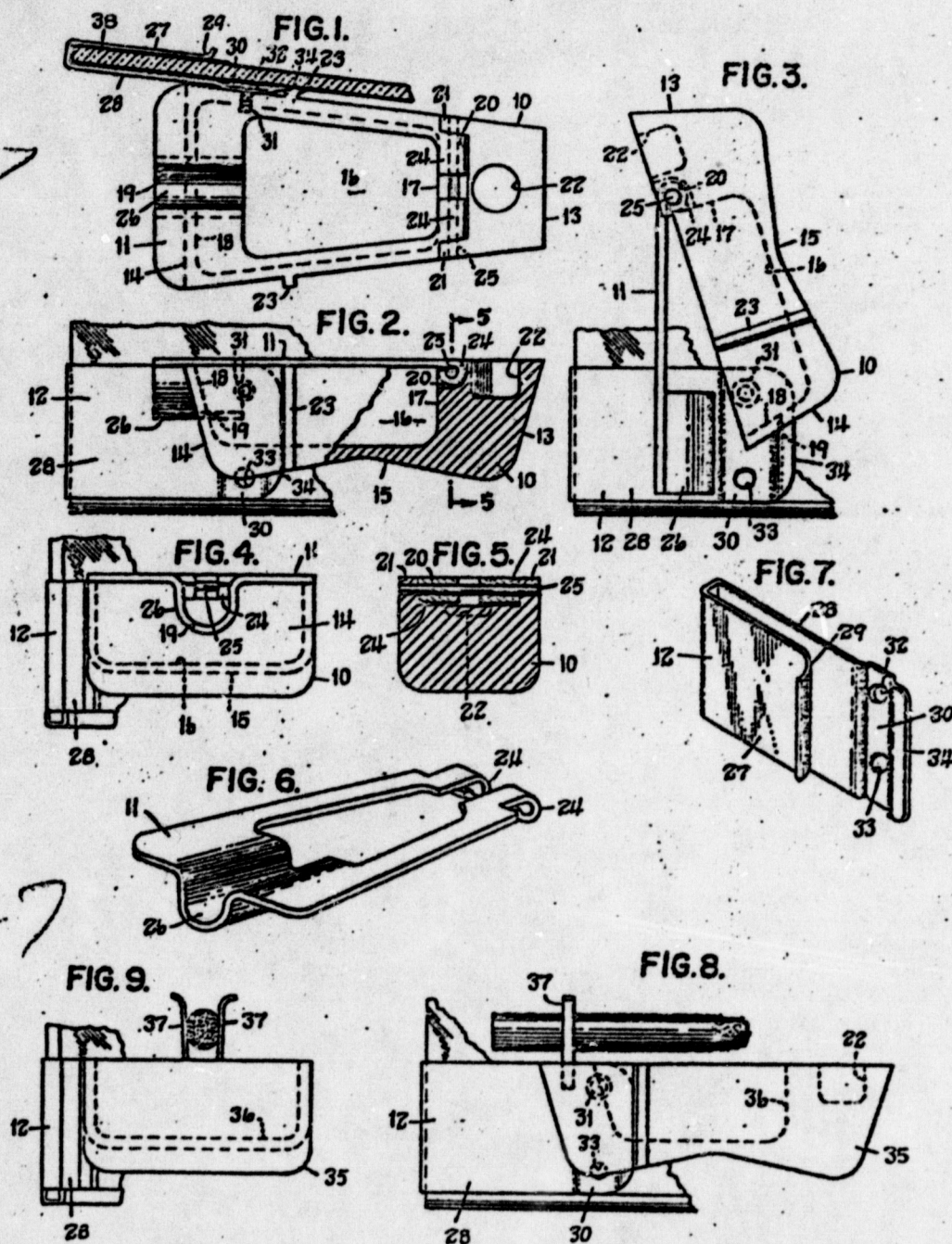
3 Sheets-Sheet 3

*Fig. 11.**Fig. 12.**Fig. 13.**Fig. 14.*INVENTOR,
RALPH H. SEGAL.BY *Percy Freeman*
ATTORNEY.

June 9, 1953

H. E. STOCK
ASH TRAY FOR VEHICLES
Filed Sept. 27, 1950

2,641,264



Inventor
Herman E. Stock
By *Seymour, Cash & Nichols*
Attorneys

Sept. 10, 1946.

F. C. CHAMBERS

Des. 145,562

PIPE RECEPTACLE

Filed Oct. 8, 1945

Fig. 1

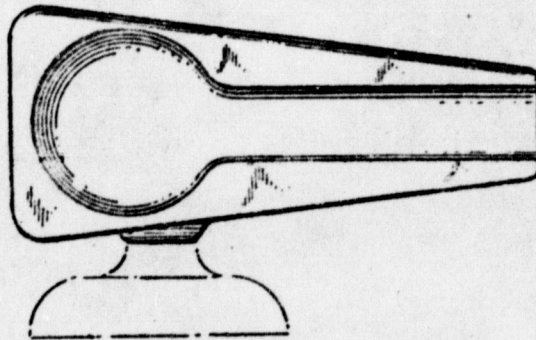


Fig. 2

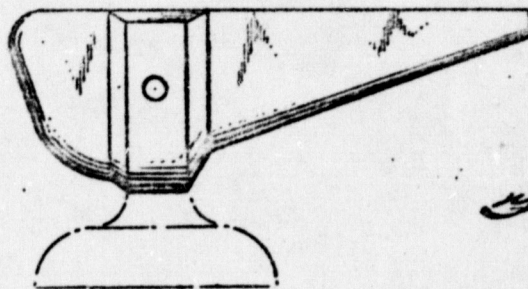


Fig. 3

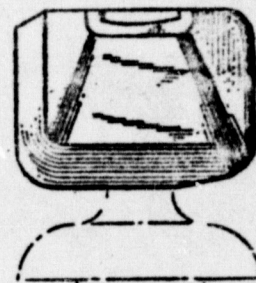
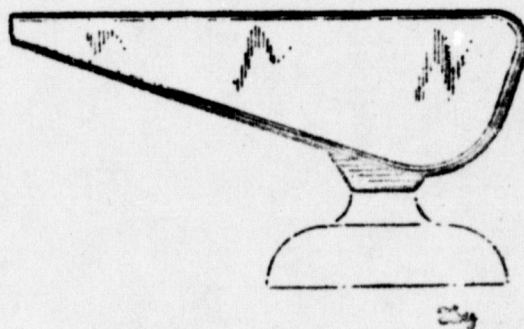


Fig. 4



Inventor
F. C. Chambers,

Barry & Coy.
Attorneys

852-④ Nathaniel Jeweler
P. 17

3-1931 4



SOUVENIR ash tray made for the Golden Rooster banquet by Art Metal Works of Newark. The rooster is golden with a bright red crest.